

III. 35 USC §103 Rejections

Claims 1-11 stand rejected under 35 USC §103 as being obvious over “prior art” disclosed in the specification and Philips Electronics N.V., “CD Recordable & CD Writable,” http://www-eu.sv.philips.com/newtech/crtech_right.html, 8/9/98 (herein “the Philips document”).

This rejection is respectfully traversed for four independent reasons. First, the Examiner has not established that the Philips document is prior art to the present application. Second, the references, even if available as prior art, fail to disclose or suggest all elements of the claimed invention. Third, any motivation to add missing features to the references is the product of impermissible hindsight. Fourth, the references in fact teach away from the present invention.

A. The Philips Document Cannot be Regarded as Prior Art

The Philips document does not have a known date of publication. The Philips document is an Internet document that the Applicant printed on August 9, 1998 and submitted on an Information Disclosure Statement dated August 26, 1998. The Applicant has never admitted that the Philips document is prior art. The only date appearing on the submitted print-out of the document is the August 9, 1998 date of printing. Without any evidence of earlier posting or publication, the Examiner cannot assume that the Philips document was published at any time before this date. The Examiner certainly cannot assume that the Philips document was published before the Applicant’ filing date, which is March 3, 1997. The Examiner is respectfully requested to either present proof that the Philips document is prior art to the Applicant’s invention or withdraw the rejection.

In the event that the Examiner can either show that the Philips document qualifies as prior art or find a prior art reference disclosing the same thing, the Applicant still requests withdrawal of the rejection for two additional reasons, as the next two sections establish.

B. The References Fail to Disclose or Suggest All Claimed Elements.

MPEP § 2143.03 informs us, “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In this case, neither the Applicant’s admitted prior art nor the Philips document teach or suggest a “ring having a portion that covers the power calibration area.” (claim 1), “an abrasive tool . . . adapted to abrade the power calibration area” (claim 5), “shielding the power calibration area” (claim 6), or “covering the power calibration area” (claim 7).

Consider the only two admissions of prior art from the Applicant’s specification: (1) that certain mechanisms for write protection are well known, and (2) that power calibration and a power calibration area are well known. The Examiner also notes that the Philips document discloses optimum power calibration using a program calibration area. However, claim 1 refers to a “ring having a portion that covers the power calibration area” The Applicant’s specification in no way admits that such a “ring” was known in the prior art. No prior art discloses a “ring” or any other device that “covers” part of the medium or the power calibration area. Instead, covering part of the medium or, more specifically, the power calibration area is part of the Applicant’s advancement over the prior art. That is, the “ring” of claim 1 is a teaching from the Applicant and, therefore, is not part of the prior art from which the Examiner can rely. The same applies to the limitations quoted above from the other independent claims.

The Philips document adds nothing to the Applicant’s admitted prior art. The Philips document describes the program calibration area (PCA) of a CD-R or CD-RW disc, but the document never mentions a “ring” of any sort and certainly not a “ring having a portion that covers the power calibration area”. Likewise, the Philips document does not mention “an abrasive tool”, “shielding the power calibration area”, or “covering the power calibration area”.

Because neither the Applicant’s admitted prior art nor the Philips document teaches or suggests the indicated limitations of the independent claims, no conceivable combination of the two references can yield the present invention. Therefore, the Applicant kindly requests that the Examiner withdraw the rejection.

C. Impermissible Hindsight.

As explained above, neither of the two references, even if both were available as prior art, disclose or suggest a “ring”, “abrasive tool”, “shielding the power calibration area” or “covering the power calibration area”; and no combination of the two references could possibly yield those elements of the claimed invention. If it is the Examiner’s position that it would have been obvious to one of ordinary skill to add these elements to what the references teach, then the Examiner has engaged in impermissible hindsight. This is apparent by tracing through the Examiner’s reasoning.

In making the rejection, the Examiner relies upon two admissions of prior art from the Applicant’s specification: (1) that certain mechanisms for write protection are well known, and (2) that power calibration and a power calibration area are well known. The Examiner also notes that the Philips document discloses optimum power calibration using a program calibration area. The Examiner next concludes, “It is obvious when the power calibration area is covered (by any means, such as a ring, since it is a circular area), the laser power calibration becomes impossible, which this can affect the operation of the system such as preventing the disk from rewriting.”

The Examiner has simply stated that one can conclude, as an obvious matter, that an effect of covering the power calibration area is to prevent rewriting of the disk. However, this does not imply that it would have been obvious to cover the power calibration area in the first place. The effect of covering the power calibration area, given that it is covered, may be obvious, but the idea to cover it in the first place is not obvious.

Hence, the Examiner’s next statement, “Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to cover the calibration area in order to affect the operation of the system, operation such as rewriting the disk,” is logically incorrect. The Examiner’s reasoning has not demonstrated obviousness to cover (or abrade or shield) the power calibration area. A *prima facie* showing of obviousness requires a suggestion or motivation from the prior art. As explained in MPEP § 2143.03,

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure.

The Applicant respectfully submits that the suggestion or motivation is not present in the prior art. The Applicant's admissions of prior art are strictly limited to the two enumerated points listed above and do not extend to "the operation of the system, operation such as rewriting the disk." Likewise, the Philips document, assuming it could even be prior art, never mentions the Examiner's motivation of "affect[ing] the operation of the [Applicant's] system, operation such as rewriting the disk."

Instead, the Examiner's motivation has been taken directly from the Applicant's own specification. Page 2, lines 5-7 of the specification states, "There is a need for a physical write protect feature, directly on the disk medium, that protects against writing for any software." On the same page, lines 18-24, the specification explains how the Applicant has achieved this objective:

In some example embodiments of the invention, the Power Calibration Area is temporarily obscured, preventing a successful calibration. For example, the Power Calibration Area may be covered by removable opaque plastic rings or adhesive labels. In other example embodiments, the Power Calibration Area is permanently obscured or covered for permanent write protection. For example, the surface of the disk in the Power Calibration Area may be scratched or abraded.

It is impermissible hindsight for the Examiner to use the Applicant's own teachings against him. The Applicant respectfully requests that the Examiner either produce evidence from the prior art to show the motivation for modifying the references or withdraw the rejection.

D. The Prior Art Teaches Away from the Claimed Invention

Not only does the prior art fail to provide a motivation for covering, shielding or abrading the power calibration area, but the prior art also teaches away from covering, shielding or abrading the power calibration area. The prior art is concerned with the rewritability and

erasability of disks having a power calibration area. Covering, shielding or abrading the power calibration area of a disk prevents the disk from being rewritable or erasable, thereby destroying the very properties that the prior art extolls. Therefore, any assertion by the Examiner that the prior art provides a motivation for covering, shielding or abrading the power calibration area is contrary to what the prior art teaches.

E. Summary

If the Examiner insists upon maintaining the obviousness rejection of the present claims, the Examiner is required to show each of the following: (1) the references are prior art to the Applicant's invention; (2) the references teach or suggest all claim limitations; (3) any motivation to combine, modify, or augment the references come from the references and not the Applicant's own teachings; and finally (4) the references do not teach away from the claimed invention. If the Examiner cannot demonstrate that the present obviousness rejection, or any other rejection under 35 USC §103, satisfies these four conditions, the Examiner is respectfully requested to allow the present claims.

CONCLUSION

In view of the above remarks, it is respectfully requested that the rejections be withdrawn. The Applicant believes the claims are in condition for allowance. If the undersigned can assist in expediting the issuance of the application, the Examiner is invited to telephone the undersigned representative.

Respectfully submitted,

Date: 2/3/98



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